

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 3-41, 44-46 and 49-51 are pending, new Claims 49-51 having been added by way of the present amendment. Support for the newly added claims is found in the specification as will be discussed below and therefore no new matter is added.

In the outstanding Office Action Claims 47 and 48 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; Claims 2-8, 14, 17, 20, 22-23, 25-27, 38-39, 44 and 47-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maxham et al. (U.S. Patent Publication No. 2004/0187075, hereinafter Maxham) in view of Koppich (U.S. Patent Publication No. US 2005/0141028); Claims 9 and 10 were rejected as being unpatentable over Maxham in view of Koppich and in further view of Shaughnessy et al. (U.S. Patent Publication No. 2004/0205664, hereinafter Shaughnessy); Claim 11, 19, 21 and 24 were rejected as being unpatentable over Maxham in view of Koppich and in further view of Howard (U.S. Patent No. 6,098,079); Claim 12 was rejected as being unpatentable over Maxham in view of Koppich and in further view of Chi (U.S. Patent No. 5,978,917); Claim 13 was rejected as being unpatentable over Maxham in view of Koppich and in further view of Kumashio (U.S. Patent Publication No. 2004/0193631) in further view of Howard; Claims 15 and 16 were rejected as being unpatentable over Maxham and Koppich and Shaughnessy and in further view of Riss et al. (U.S. Patent Publication No. 2004/0103367); Claim 18 was rejected as being unpatentable over Maxham and Koppich and in further view of Eagle et al. (U.S. Patent Publication No. 2003/0145209, hereinafter Eagle); Claims 29-32 and 35 were rejected as being unpatentable over Maxham and Koppich and in further view of Kenner (U.S. Patent No. 6,421,726); Claims 33 and 34 were rejected as being unpatentable over Maxham, Koppich, Kenner (U.S. Patent No. 6,421,726) and in further view of Black et

al. (U.S. Patent Publication No. 2002/0059317, hereinafter Black); Claim 36 was rejected as being unpatentable over Maxham in view of Koppich, Kenner and in further view of McIver (John McIver “AutoVue Solid Model Professional Version 15-Review”); Claim 37 was rejected as being unpatentable over Maxham and Koppich, Kenner and McIver in further view of “Windows Tips”; and Claim 41 was rejected as being unpatentable over Maxham in view of Koppich, Kenner and Krachman (U.S. Patent Publication No. 2004/0199555).

As a preliminary matter, Applicants’ representative appreciatively acknowledges the courtesy extended by Primary Examiner Truong, and Examiner Pham, for meeting with the undersigned on May 6, 2008. The discussion during the interview is reflected in the present claim amendments and the remarks that follow.

As discussed in the interview, it was agreed that Claim 2 does not clearly articulate what Applicants believed were the distinguishing features between the present invention and the asserted prior art. Therefore, to promote efficient prosecution in this case, Claim 2 has been canceled and replaced with Claim 49.¹ As discussed in the interview, the invention defined by Claim 49 is directed to a device that loads data at a user-site, and after performing various steps on the data, ultimately outputs the output file in a user-specified export format for either exporting, reviewing or searching the output file in an external system. As explained by Applicants during the interview, an advantage of such a device that can be hosted at a user facility is that the user has complete control over all security aspects of the electronic discovery, and is also in control of all processing that is performed on the data. The concept of having a device at a particular location is reflected in Claim 49, by several requirements including: (1) physically locating and copying data...at a user-site, (2) receiving

¹ Support for Claim 49 is found throughout the specification, for example the “physically” step is found in Fig. 7 (see e.g., hard disk, and removable media drive 1208); the “storing” step also found in Fig. 7, as well as specification [0023]; storing step found in Fig. 7, and pg. 8, first bullet; support for the “converting” step being found in Fig. 6 and Fig. 2, step S27 for example; the processing and converting step also being found in Figs. 6 and 2 for example; and the “outputting” step being found in Fig. 2, element S29. Therefore no new matter is added.

on-site user input..., (3) storing in a local storage device..., (4) and outputting the output file in a user-specified format for exporting, reviewing and searching the output file in an external system.

With regard to the specifics of Claim 49, Claim 49 is directed to a method that physically loads and copies data and associated meta-data at a user site. The method then receives on-site user input for subsequent processing of a working copy of the data and associated meta-data. The working copy is stored in a local device while maintaining a document context with respect to other documents. As discussed during the interview, the “document context”, describes the relationships between documents such as a parent-child relationship (for support see original Claim 5, for example). The claimed method then performs a step of converting a selected file if convertible to a user-specified format (note that Claim 3 describes that the converting step identifies a file that is not convertible as a “exception file”). When converting, the converting extraction saves the file meta-data, extracts text and creates an image of the selected file. The method then processes and converts the selected file to an output file in the user-specified export format. Finally, the method outputs the output file in the user-specified format for either exporting, reviewing or searching the output file on an external system.

The rejection of original Claim 2, was based on Maxham and Koppich. However as discussed during the interview, Maxham is directed to a system that is web-based on the web vendor service. Therefore, at a client side documents need to be uploaded, processed and saved in a computer cluster according to Maxham. Thus a client would lose control over the data, and the processing performed on that data.

Koppich, is also directed to a web-based system that uses remote pre-approved script based searches of data in storage areas. Essentially, Koppich is directed to a data management and retrieval system that is web-based.

During the interview, new Claim 49 was compared and contrasted with Maxham and Koppich, noting that neither Maxham nor Koppich operated on the concept of an on-site method for loading, processing, converting and then ultimately outputting the output file in the user-specified format, as claimed. In particular, neither Maxham nor Koppich teaches or suggests the concept of having an on-site method for performing the claimed features. In particular, it is respectfully submitted that neither Maxham nor Koppich teach or suggest claim element “physically loading...”, “receiving”, “storing”, and “outputting”, as claimed. Even assuming *arguendo*, that a tertiary reference was found for selected claim elements, it is respectfully submitted that altering Maxham or Koppich to be in a site-based system would defeat the primary purposes of both Maxham and Koppich. Therefore, it is respectfully submitted that any combination of Maxham and Koppich used in combination with a tertiary reference, would not render obvious the invention defined by amended Claim 49.

Although each of the other claims is of very differing scope and/or statutory class, it is respectfully submitted that these other claims also patentably define over the asserted prior art for at least the same reasons discussed above with regard to Claim 49.

As Claims 47 and 48 have been canceled without prejudice or disclaimer it is respectfully submitted that the rejection under 35 U.S.C. § 101 is now moot.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by the presently pending claims is patentably distinguishing from the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this rejection is therefore requested.

Respectfully submitted,

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